

REMARKS

Applicants respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Status of Claims

Claim 22 is currently amended. Support for amended claim 22 can be found in the specification as filed on page 25 at paragraph [0074] and at Figure 5E. No new matter is being introduced by the amendment. Claim 53 is cancelled. Upon entry of this response, claims 22-33, 35-38, 42 and 52 are pending examination on the merits.

Interview Summary

Applicants appreciate the courtesy extended by Examiner Van on July 8, 2008, in conducting a telephone interview with Applicants' representative. The Examiner acknowledged during the interview that Ohkura does not suggest multi-level arrays of nanopores within larger pores, such as for example the ones described in paragraph [0074] and Figure 5E in the present application. The Examiner indicated that the previously pending claim 22 recited a broader arrangement, in which groups of nanopores qualify as the recited "cells" and suggested revising claim 22 to expressly recite nanopores within larger pores. In response, claim 22 has been amended according to the Examiner's helpful suggestion.

Claims 22-27, 32, 36-38, 42, and 52 Are Not Obvious Over Ohkura

Claims 22-27, 32, 36-38, 42, and 52 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,610,463 to Ohkura *et al.* ("Ohkura"). Although the Office acknowledges that Ohkura, "does not explicitly teach anodizing the first material under a first and second condition," the Office alleges the claimed invention is obvious. Office Action, pp. 3-7. Applicants respectfully traverse.

Based on the Interview and the Examiner's helpful suggestion, independent claim 22 is currently amended to further highlight the differences between the claimed invention and the disclosure of Ohkura. Presently, claim 22 recites "anodically oxidizing said first material under a first condition to form a plurality of separated cells, wherein each separated cell is a

macropore with the controlled first pattern in the anodically oxidized first material, and anodically oxidizing said first material under a second condition to form a nanopore array such that the nanopores of the nanopore array are located within the macropores.” Thus, claim 22 recites nanopores located in macropores. In contrast, Ohkura neither describes nor suggests a plurality of anodization steps to form macropore cells, **and** a subsequent anodization step to form an ordered pattern of nanopores **within** said macropores. Thus, Ohkura fails to render the presently claimed invention obvious.

The Office Action states that Ohkura teaches oxidizing aluminum using different voltages in order to control interval between pores and that it would have been obvious to have used a second oxidizing condition in the process of Ohkura to change the diameter of pores. Applicants respectfully disagree that it would have been obvious to use two different oxidizing conditions in the process of Ohkura. However, even if it was obvious to use two different oxidizing conditions, then Ohkura still does not teach or suggest forming nanopores within macropores as recited in claim 22.

In addition, because dependent claims cannot be obvious unless the independent claim is obvious, the rejections of claims 23-27, 32, 36-38, 42, and 52, which depend from independent claim 22, are improper and should also be withdrawn. *See* MPEP § 2143.03 (If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

For at least these reasons, Applicants therefore respectfully request reconsideration and withdrawal of the rejection.

Dependent Claims 28-31, 33 And 35 Are Not Obvious

Claims 28-31, 33 and 35 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Ohkura in view of Zhang et al. (US 6,709,929) (“Zhang”), Iwasaki et al. (US 6,278,231) (“Iwasaki”) or Sekinger et al. (US 5,975,976) (“Sekinger”). Office Action, page 7-10. Applicants respectfully traverse.

Citing Ohkura in view of Zhang, Iwasaki, and Sekinger, the Office alleges the aforementioned dependent claims are obvious. For the reasons discussed above, Ohkura fails

to the render the presently claimed invention obvious, and neither Zhang, Iwasaki nor Sekinger alone or in combination cure the deficiencies of Ohkura.

Further, since dependent claims cannot be obvious unless the independent claim is obvious, the rejections of claims 28-31, 33 and 35, which ultimately depend from independent claim 22, are not obvious. *See* MPEP § 2143.03 (If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

For at least these reasons, Applicants therefore respectfully request reconsideration and withdrawal of the rejection.

CONCLUSION

Applicants submit that the present application is in condition for allowance, and an early indication to this effect is requested. Examiner Van also is invited to contact the undersigned directly, should she feel that any issue warrants further consideration.

The Commissioner is hereby authorized to charge any additional fees, which may be required under 37 CFR §§ 1.16-1.17, and to credit any overpayment to Deposit Account No. 19-0741. Should no proper payment accompany this response, then the Commissioner is authorized to charge the unpaid amount to the same deposit account. If any extension is needed for timely acceptance of submitted papers, Applicants hereby petition for such extension under 37 CFR §1.136 and authorize payment of the relevant fee(s) from the deposit account.

Respectfully submitted,

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